

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

REMARKS/ARGUMENT

Applicants respectfully request under 37 C.F.R. 116(b) and MPEP 706.07(c) reconsideration and withdrawal of the finality of the rejection of Claims 15-19, 21-23, 28 and 30-46. Applicants respectfully point out that the rejection of Claims 43-46 are new rejections not previously set forth by the Examiner and not in response to any amendments submitted by Applicants. As such, the finality of the rejection of Claims 15-28 and 30-46 is improper and should be withdrawn.

Applicants again restate the fact that the Examiner canceled Claims 8-11 by Examiner's amendment on May 20, 2002. The Examiner, however, was without authority to cancel Claims 8-11 the rejection of which was REVERSED by the Board of Appeals in its Decision on Appeal dated March 8, 2002 (see page 7, line 11 -- page 8, line 3 & page 9, lines 9-10). The Examiner graciously admits his mistake in the Office Action dated April 29, 2005. The Examiner goes on to explain that he was instructed to treat canceled Claims 8-11 as newly added Claims 43-46. Nevertheless, Claims 43-46 are word for word identical to Claims 8-11 the rejection of which was reversed by the Board of Appeals and should be treated no differently in prosecution whether they are identified as Claims 8-11 or 43-46 and should be treated as if they were present in the application before and after March 4, 2003.

Applicants also wish to set the record straight. The Examiner states in his Office Action of April 29, 2005, that Applicants accepted the canceling of the claims in the paper of 3/04/03 (Office Action, page 2, lines 5-7). Nothing could be farther from the truth, for the reasons set forth below:

- a) The Board reversed the rejection of Claims 8-11 on March 8, 2002. Accordingly, pursuant to MPEP 1406, prosecution on Claims 8-11, 15-17, 18 and 19-28 was

TI-22187

9

PAGE 15/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2733639 * CSID:972 917 4417 * DURATION (mm-ss):09-20

PAGE 15/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

closed except for formal matters (placing dependent claims 8-11 in condition for allowance);

- b) The cancellation by the Examiner of Claims 8-11 on March 8, 2002 was an action "on the merits", prohibited under MPEP 1406;
- c) The Examiner's action of canceling Claims 8-11 is also a re-opening of prosecution which was NOT authorized by written authority of the Commissioner of Patents as required by 37 CFR 1.198 & MPEP 1214.07. As such, the cancellation of Claims 8-11 is/was an illegitimate action, which CANNOT be made "legitimate" by any response or failure to respond by Applicants. As such, the director's determination that applicants accepted the canceling of the claims in the paper of 3/04/03 is improper and must be withdrawn.

1) Objected to Claims 20, 24 and 26 have been rewritten in independent form to include all of the limitations of their respective base claims. As such, Claims 20, 21, 24, 25, 26 and 27 stand allowable.

Claim 21 depends from allowable Claim 20 and is therefore allowable.

Claim 25 depends from allowable Claim 24 and is therefore allowable.

Claim 27 depends from allowable Claim 26 and is therefore allowable.

2) Claims 15, 17, 19, 22-23, 28 and 30-42 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No.5,249,218 to Sainton. Applicants respectfully traverse this rejection, as set forth below.

TI-22187

10

PAGE 16/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2733639 * CSID:972 917 4417 * DURATION (mm-ss):09-26

PAGE 16/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

In order that the rejection of Claim 15 be sustainable, it is fundamental that "each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference." Verdegall Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also, Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), where the court states, "The identical invention must be shown in as complete detail as is contained in the ... claim".

Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Independent Claim 15 requires and positively recites a computer, comprising: "a provision for user input", "a provision for output", "a microprocessor coupled to said user input and said output" and "an interface coupled to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone".

Independent Claim 30 requires and positively recites, an apparatus, comprising: "an input", "an output", "a microprocessor coupled to said input and said output" and "an interface coupled to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in another apparatus, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said another apparatus".

TI-22187

11

PAGE 17/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2738300 * CSID:972 917 4417 * DURATION (mm-ss):05-25

PAGE 17/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/536,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

Independent Claim 38 requires and positively recites, a method, comprising the steps of: "providing an input", "providing an output", "coupling a microprocessor to said input and said output" and "coupling an interface to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in another apparatus, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said another apparatus".

In contrast, Sainton clearly discloses in Figure 3 that the connector (112) of modem (10) in computer (104) (the interface for computer 104) is coupled via a 3FT. black round cable (114) to a corresponding connector (118) in cellular phone (116). As a result, there is NO DIRECT CONNECTION between connector (112) of computer (110) and connector (118) of cellular phone (116), or the suggestion of any direct connection between connector (112) of computer (110) and connector (118) of cellular phone (116). As such, Sainton fails to teach or suggest, "an interface coupled to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone", as required by Claim 15, "an interface coupled to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in another apparatus, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said another apparatus", as required by Claim 30, and "coupling an interface to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in another apparatus, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for

TI-22187

12

PAGE 18/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2733639 * CSID:972 917 4417 * DURATION (mm:ss):09:26

PAGE 18/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm:ss):09:20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

connection to corresponding leads in a corresponding interface in said another apparatus", as required by Claim 38.

Moreover, Applicants would like to point out that connector (112) is identified as being an RJ45 connector while connector of cellular phone (116) is identified as being a 2303 – which are not compatible connectors. Indeed, cable (114) in Fig. 3 shows a corresponding RJ-45 plug (228) at one end of the cable for connecting with connector (112) and a corresponding 2302 plug (230) for connecting with connector (118). Accordingly, the 35 U.S.C. 102(b) rejection of Claims 15, 30 and 38 is overcome.

Support for the amendment to Claim 15 of the language "without a cable or tethered connection" is located on at least, page 19, lines 2-6; page 25, lines 25-27; page 26, lines 4-6 and page 59, lines 2-6 of the specification. Moreover the Examiner seems to acknowledge this distinguishing limitation over Sainton, where he states: "If the applicants wish to claim this direct connection means there is no conducting element connecting the computer to the telephone applicants need only claim this, and indicate where support for this lack of a conductive element is in the specification" (Office Action, page 2, lines 20-22).

Claims 17, 19, 22-23, 28, 31-37 and 39-42 stand allowable as depending directly, or indirectly, from allowable Claims 15, 30 or 38 and including further limitations not taught or suggested by the references of record.

Claim 17 further defines the computer of Claim 15, wherein said at least one command channel lead facilitates a bidirectional half duplex mode. Claim 17 is allowable for the reasons set forth in support of the allowance of Claim 15.

TI-22187

13

PAGE 19/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXXRF-6/24 * DNIS:2733630 * CSID:972 917 4417 * DURATION (mm-ss):09-26

PAGE 19/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFXXRF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

Claim 19 further defines the computer of Claim 15, wherein voice and data are transmitted on said at least one voice channel lead. Claim 19 is allowable for the reasons set forth in support of the allowance of Claim 15. Moreover, contrary to the assertion of the Examiner Sainton does NOT teach or suggest that its voice channel can be used for Data & Audio. Indeed, Sainton teaches data on the DIO/DATA line and audio on the TX/TXAF and possibly RX/SPK lines. Should the Examiner maintain this rejection, Applicants respectfully request the Examiner to identify the specific teaching in Sainton that teaches that a voice channel can be used for Data & Audio.

Claim 22 further defines the computer of Claim 15, wherein said interface coupled to said microprocessor further includes a second voice channel lead. Claim 22 is allowable for the reasons set forth in support of the allowance of Claim 15.

Claim 23 further defines the computer of Claim 22, wherein each of said voice channel leads facilitates a unidirectional full duplex mode. Claim 23 is allowable for the reasons set forth in support of the allowance of Claim 22.

Claim 28 further defines the computer of Claim 23, wherein voice and data are transmitted on said voice channel leads. Claim 28 is allowable for the reasons set forth in support of the allowance of Claim 23. Moreover, contrary to the assertion of the Examiner Sainton does NOT teach or suggest that its voice channel can be used for Data & Audio. Indeed, Sainton teaches data on the DIO/DATA line and audio on the TX/TXAF and possibly RX/SPK lines. Should the Examiner maintain this rejection, Applicants respectfully request the Examiner to identify the specific teaching in Sainton that teaches that a voice channel can be used for Data & Audio.

Claim 31 further defines the apparatus of Claim 30 further including one of a keypad and keyboard coupled to said input. Claim 31 is allowable for the reasons set forth in

TI-22187

14

PAGE 20/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2738300 * CSID:972 917 4417 * DURATION (mm-ss):09-26

PAGE 20/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

support of the allowance of Claim 30. Moreover, Sainton does not teach a keyboard or keypad coupled to the input of cellular phone 116.

Claim 32 further defines the apparatus of Claim 30 further include a display coupled to said output. Claim 32 is allowable for the reasons set forth in support of the allowance of Claim 30. Moreover, Sainton does not teach a display coupled to an output of cellular phone 116.

Claim 33 further defines the apparatus of Claim 30, wherein said apparatus is a computer. Claim 33 is allowable for the reasons set forth in support of the allowance of Claim 30.

Claim 34 further defines the apparatus of Claim 33, wherein said another apparatus is a portable telephone. Claim 34 is allowable for the reasons set forth in support of the allowance of Claim 33.

Claim 35 further defines the apparatus of Claim 30, wherein said apparatus is a portable telephone. Claim 35 is allowable for the reasons set forth in support of the allowance of Claim 30.

Claim 36 further defines the apparatus of Claim 35, wherein said another apparatus is a computer. Claim 36 is allowable for the reasons set forth in support of the allowance of Claim 35. Moreover, Sainton discloses only a computer 104 coupled to a radiotelephone 116 – NOT two computers coupled to each other.

Claim 37 further defines the apparatus of Claim 30, wherein said portable telephone is a cellular telephone. Claim 37 is allowable for the reasons set forth in support of the allowance of Claim 30.

TI-22187

15

PAGE 21/31 * RCVD AT 9/19/2005 2:57:16 PM [Eastern Daylight Time] * SVR:USPTO-EFAX-6/24 * DNS:2733639 * CSID:972 917 4417 * DURATION (mm-ss):09-28

PAGE 21/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFAX-6/30 * DNS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

Claim 39 further defines the method of Claim 38, wherein said apparatus is a computer. Claim 39 is allowable for the reasons set forth in support of the allowance of Claim 38.

Claim 40 further defines the method of Claim 39, wherein said another apparatus is a portable telephone. Claim 40 is allowable for the reasons set forth in support of the allowance of Claim 39.

Claim 41 further defines the method of Claim 38, wherein said apparatus is a portable telephone. Claim 41 is allowable for the reasons set forth in support of the allowance of Claim 38.

Claim 42 further defines the method of Claim 41, wherein said another apparatus is a computer. Claim 42 is allowable for the reasons set forth in support of the allowance of Claim 41. Moreover, Sainton discloses only a computer 104 coupled to a radiotelephone 116 – NOT two computers coupled to each other.

2) Claims 16 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of KYU et al PN 4,225,919. Applicants respectfully traverse this rejection as set forth below.

Claims 16 and 21 dependent directly, or indirectly, from Claim 15. Therefore, Claims 16 and 21 are allowable over the Sainton reference for the same reasons set forth above in support of the allowance of Claim 15. Even if, *arguendo*, Kyu et al teaches two basic types of data links are well known, including both bidirectional half-duplex and unidirectional full-duplex, Kyu provides no teaching whatsoever that overcomes the failing of the Sainton reference – i.e., Sainton does not teach or suggest the interfaces of the computer and the portable telephone being directly connectable without a cable or

TI-22187

16

PAGE 22/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXXRF-6/24 * DNIS:2733639 * CSID:672 617 4417 * DURATION (mm-ss):09-26

PAGE 22/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFXXRF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

tethered connection to a corresponding interface in a portable telephone. And even if would have provided such teaching, the Examiner's motivation for combining the two references would only truly be a motivation to one having ordinary skill in the art if the amount of voice channel information is small enough to allow use of a single voice channel lead having a bidirectional half duplex mode. The Examiner has produced no evidence that one of Sainton's audio lines could be omitted without compromising the objective and functionality of the Sainton apparatus.

3) Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Dent et al PN 4,225,919. Applicants respectfully traverse this rejection as set forth below.

Claim 18 depends directly from Claim 15. Therefore, Claim 18 is allowable over the Sainton reference for the same reasons set forth above in support of the allowance of Claim 15.

4) Claims 43-44 and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090. Applicants respectfully traverse this rejection as set forth below.

Independent Claim 43, as amended, requires and positively recites, a computer, comprising: "a provision for user input", "a provision for output", "a microprocessor coupled to said user input and said output" and "an interface coupled to said microprocessor, said interface being located within a cavity in said computer and directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto, wherein said interface comprises at least one

TI-22187

17

PAGE 23/31 * RCVD AT 8/16/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXXRF-6/24 * DNIS:2733638 * CSID:972 917 4417 * DURATION (mm-ss):09-25

PAGE 23/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFXXRF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone".

Independent Claim 46, as amended, requires and positively recites, a computer, comprising: "a provision for user input", "a provision for output", "a microprocessor coupled to said user input and said output", "an interface coupled to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto" and "a mechanism on said computer that cooperates with a corresponding mechanism on said portable telephone for removably securing said portable telephone to said computer".

In contrast, Sainton clearly discloses in Figure 3 that the connector (112) of modem (10) in computer (104) (the interface for computer 104) is coupled via a 3FT, black round cable (114) to a corresponding connector (118) in cellular phone (116). As a result, there is NO DIRECT CONNECTION WITHOUT A CABLE OR TETHER between connector (112) of computer (110) and connector (118) of cellular phone (116), or the suggestion of any direct connection between connector (112) of computer (110) and connector (118) of cellular phone (116). As such, Sainton fails to teach or suggest, "an interface coupled to said microprocessor, said interface being located within a cavity in said computer and directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone", as required by Claim 43 and "an interface coupled to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto" and "a mechanism on said computer that cooperates with a corresponding mechanism on said portable telephone for removably securing said portable telephone to said computer", as required by Claim 46.

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

The Examiner relies upon Morris as teaching "a laptop computer including an interface (94) located within a cavity (mounting Track Figure 2) for holding a cellular telephone". Applicants respectfully point out that the battery pack must be removed from cellular portable telephone 38 before it can be attached to computer 22 (ABSTRACT, lines 4-6 & col. 1, lines 47-49). In contrast, a battery is coupled to Applicants portable telephone while its interface is coupled to the interface of the computer. Morris' portable telephone cannot be coupled to computer 22 since the same mechanism on the phone that is used to attach the battery is used to couple its portable telephone to computer 22. As such, Morris does not overcome the previously described deficiencies of Sainton. As such, any combination of Sainton and Morris fails to teach or suggest "an interface coupled to said microprocessor, said interface being located within a cavity in said computer and directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone", as required by Claim 43 and "an interface coupled to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto" and "a mechanism on said computer that cooperates with a corresponding mechanism on said portable telephone for removably securing said portable telephone to said computer", as required by Claim 46. The 35 U.S.C. 103(a) rejection of Claims 43 and 46 over Sainton in view of Morris is overcome.

Claim 44 depends from Claim 43 and is therefore similarly allowable.

5) Claim 45 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090 as applied to claim 43 above

TI-22187

19

PAGE 25/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFAXF-6/24 * DNIS:2733039 * CSID:972 917 4417 * DURATION (mm-ss):09-28

PAGE 25/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFAXF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

and further in view of Kobayashi PN 5,111,361. Applicants respectfully traverse this rejection as set forth below.

Independent Claim 43, as amended (the claim from which Claim 45 depends), requires and positively recites, a computer, comprising: "a provision for user input", "a provision for output", "a microprocessor coupled to said user input and said output" and "an interface coupled to said microprocessor, said interface being located within a cavity in said computer and directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone".

Dependent Claim 45 further defines the computer of Claim 43, wherein said portable telephone fits completely within said cavity when directly connected to said interface.

In contrast, Sainton clearly discloses in Figure 3 that the connector (112) of modem (10) in computer (104)(the interface for computer 104) is coupled via a 3FT. black round cable (114) to a corresponding connector (118) in cellular phone (116). As a result, there is NO DIRECT CONNECTION WITHOUT A CABLE OR TETHER between connector (112) of computer (110) and connector (118) of cellular phone (116), or the suggestion of any direct connection between connector (112) of computer (110) and connector (118) of cellular phone (116). As such, Sainton fails to teach or suggest, "an interface coupled to said microprocessor, said interface being located within a cavity in said computer and directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone", as required by Claim 43.

Application No. 08/586,777
Amendment dated May 23, 2005
Reply to Office Action of April 29, 2005

The Examiner relies upon Morris as teaching "a laptop computer including an interface (94) located within a cavity (mounting Track Figure 2) for holding a cellular telephone". Applicants respectfully point out that the battery pack must be removed from cellular portable telephone 38 before it can be attached to computer 22 (ABSTRACT, lines 4-6 & col. 1, lines 47-49). In contrast, a battery is coupled to Applicants portable telephone while its interface is coupled to the interface of the computer. Morris' portable telephone cannot be coupled to computer 22 since the same mechanism on the phone that is used to attach the battery is used to couple its portable telephone to computer 22. As such, Morris does not overcome the previously described deficiencies of Sainton. As such, any combination of Sainton and Morris fails to teach or suggest "an interface coupled to said microprocessor, said interface being located within a cavity in said computer and directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone", as required by Claim 43.

The Examiner admits that Sainton and Morris do not disclose that the cellular telephone can fit completely within the cavity of a computer (Office Action, page 7, lines 5-6) but goes on to rely upon Kobayashi as teaching that a battery can fit completely within the computer. The Examiner suggests, "it would have been obvious to fit Morris's cellular telephone completely within the computer flush with the surface because this would have been aesthetically pleasing" (Office Action, page 7, lines 8-10). Applicants respectfully point out that the Examiner has cited no prior art that teaches or suggests such combination. The Examiner's determination is supposition not supported by fact. In proceedings before the Patent and Trademark Office, "the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art". In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984)). "The Examiner can satisfy this burden only by showing some

TI-22187

21

PAGE 27/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2733639 * CSID:972 917 4417 * DURATION (mm-ss):09-25

PAGE 27/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references", In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lahu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Where is the teaching relied upon by the Examiner that would lead one of ordinary skill in the art to place a cellular phone completely within a cavity of a computer?

Even if, arguendo, all of the limitations of Claim 45 would have been present when all of the references are combined, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined ONLY if there is some suggestion or incentive to do so." ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Moreover, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). The Examiner has not set forth a prima facie case of the obviousness of Claim 45. Accordingly, the 35 U.S.C. 103(a) rejection of Claim 45 is overcome.

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

6) Claims 43-44 and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hop PN 4,912,756 in view of Morris PN 5,020,090. Applicants respectfully traverse this rejection as set forth below.

Independent Claim 43, as amended, requires and positively recites, a computer, comprising: "a provision for user input", "a provision for output", "a microprocessor coupled to said user input and said output" and "an interface coupled to said microprocessor, said interface being located within a cavity in said computer and **directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto**, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone".

Independent Claim 46, as amended, requires and positively recites, a computer, comprising: "a provision for user input", "a provision for output", "a microprocessor coupled to said user input and said output", "an interface coupled to said microprocessor, said interface being **directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto**" and "a mechanism on said computer that cooperates with a corresponding mechanism on said portable telephone for removably securing said portable telephone to said computer".

In contrast, Hop clearly discloses in Figure 2 that COM1 is coupled to interface circuit 3 by a bidirectional serial bus 22. As a result, there is NO DIRECT CONNECTION WITHOUT A TETHER OR CABLE between COM1 and Interface Circuit 3. As such, Hop fails to teach or suggest, "an interface coupled to said microprocessor, said interface being located within a cavity in said computer and **directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto**, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for

TI-22187

23

PAGE 29/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFAXF-6/24 * DNIS:2733630 * CSID:972 917 4417 * DURATION (mm-ss):09-25

PAGE 29/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFAXF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

connection to corresponding leads in a corresponding interface in said portable telephone", as required by Claim 43 and "an interface coupled to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto" and "a mechanism on said computer that cooperates with a corresponding mechanism on said portable telephone for removably securing said portable telephone to said computer", as required by Claim 46.

The Examiner relies upon Morris as teaching "a laptop computer including an interface (94) located within a cavity (mounting Track Figure 2) for holding a cellular telephone". Applicants respectfully point out that the battery pack must be removed from cellular portable telephone 38 before it can be attached to computer 22 (ABSTRACT, lines 4-6 & col. 1, lines 47-49). In contrast, a battery is coupled to Applicants portable telephone while its interface is coupled to the interface of the computer. Morris' portable telephone cannot be coupled to computer 22 since the same mechanism on the phone that is used to attach the battery is used to couple its portable telephone to computer 22. As such, Morris does not overcome the previously described deficiencies of Hop. As such, any combination of Sainton and Morris fails to teach or suggest "an interface coupled to said microprocessor, said interface being located within a cavity in said computer and directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone", as required by Claim 43 and "an interface coupled to said microprocessor, said interface being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto" and "a mechanism on said computer that cooperates with a corresponding mechanism on said portable telephone for removably securing said portable telephone to

TI-22187

24

PAGE 30/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2738300 * CSID:972 917 4417 * DURATION (mm-ss):09-28

PAGE 30/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20

Application No. 08/586,777
Amendment dated May 25, 2005
Reply to Office Action of April 29, 2005

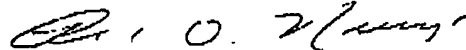
said computer", as required by Claim 46. The 35 U.S.C. 103(a) rejection of Claims 43 and 46 over Morris in view of Morris is overcome.

Claim 44 depends from Claim 43 and is therefore similarly allowable.

Applicants have challenged this final rejection as being premature and have requested that the finality of the rejection be withdrawn, as set forth above. Even if the finality of the rejection had been appropriate, this amendment should be entered since it will place the case either in condition for allowance or in better form for appeal. 37 C.F.R. 1.116; MPEP 714.12. This amendment places the case in condition for allowance.

Objected to Claims 20, 24 and 26 have been rewritten in independent form to include all of the limitations of their respective base claims. As such, Claims 20, 21, 24, 25, 26 and 27 stand allowable. As such, Claims 20, 21, 24 and 26 stand allowable. Claims 15-19, 22, 23, 28 and new Claims 30-46, as amended, stand allowable over the references of record. Applicants respectfully request allowance of the application as the earliest possible date.

Respectfully submitted,



Ronald O. Neerings
Reg. No. 34,227
Attorney for Applicants

TEXAS INSTRUMENTS INCORPORATED
P.O. BOX 655474, M/S 3999
Dallas, Texas 75265
Phone: 972/917-5299
Fax: 972/917-4418

TI-22187

25

PAGE 31/31 * RCVD AT 9/19/2005 2:57:19 PM [Eastern Daylight Time] * SVR:USPTO-EFAXF-6/24 * DNIS:2733639 * CSID:972 917 4417 * DURATION (mm-ss):09-26

PAGE 31/31 * RCVD AT 9/19/2005 3:28:24 PM [Eastern Daylight Time] * SVR:USPTO-EFAXF-6/30 * DNIS:2738300 * CSID:7033053718 * DURATION (mm-ss):09-20